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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,420	12/13/2001	Zo-Chun Jen	5540-002	6337

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WILLIAM J. MASON
MACCORD MASON PLLC
POST OFFICE BOX 1489
WRIGHTSVILLE BEACH, NC 28480

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/017,420	Applicant(s) JEN, ZO-CHUN	
	Examiner Walter B Aughenbaugh	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-22 and 24-30 is/are pending in the application.
 4a) Of the above claim(s) 1-6 and 14-20 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 7, 8, 10-13, 21, 22, 24-30 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made to claims 7 and 21 in the Amendment filed February 10, 2004 (Amdt. C) have been received and considered by Examiner.
2. The cancellation of claim 23 in Amdt. C has been acknowledged by Examiner.

WITHDRAWN OBJECTIONS

3. The objection to claims 10-12 made of record in paragraph 6 of Paper 8 has been withdrawn due to the amendment made to claim 7 in Amdt. C.

WITHDRAWN REJECTIONS

4. The 35 U.S.C. 102 rejection of claims 7, 8 and 10-13 as being clearly anticipated by Hepp made of record in paragraph 8 of Paper 8 has been withdrawn due to the amendment made to claim 7 in Amdt. C.
5. The 35 U.S.C. 102 rejection of claim 23 as being anticipated by Jalan made of record in paragraph 9 of Paper 8 has been withdrawn due to the cancellation of claim 23 in Amdt. C.

REPEATED REJECTIONS

6. The 35 U.S.C. 102 rejection of claims 7, 8, 10-13 and 21, 22 and 24 as being anticipated by Jalan made of record in paragraph 9 of Paper 8 has been repeated for the reasons previously made of record. The amendments to claims 7 and 21 do not require a change in grounds for rejection. The size range claimed in claim 23 was incorporated in claim 21 in Amdt. C.
7. The 35 U.S.C. 103 rejection of claims 13 and 24 over Jalan made of record in paragraph 10 of Paper 8 has been repeated for the reasons previously made of record.

8. The 35 U.S.C. 103 rejection of claims 25-30 over Jalan in view of Beck et al. made of record in paragraph 11 of Paper 8 has been repeated for the reasons previously made of record.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments on pages 7-10 of Amdt. C regarding the 35 U.S.C. 102 rejection of claims 7, 8, 10-13 and 21-24 as being anticipated by Jalan have been fully considered but are not persuasive. Applicant states that "applicant's additive is one single additive among every inorganic or organic solid on earth meeting the particle size requirement"; as Applicant acknowledges, Jalan teaches the additive claimed by Applicant (i.e. barium sulfate). Applicant argues that since Applicant's claimed amount range "is encompassed within the Jalan range" and since Applicant's claimed size range "overlaps the Jalan range", that a rejection under 35 U.S.C. 103 is proper, not a rejection under 35 U.S.C. 102. However, a rejection under 35 U.S.C. 102 is appropriate because Applicant's claimed amount range (0.001-0.1wt% in claim 7 and 0.005-0.05wt% in claim 21) falls within Jalan's preferred range of 0.001-0.05wt% and because Applicant's claimed size range (~0.1 - ~2.0µm in claim 7 and ~0.2 - ~1.0µm in claim 21) overlaps with Jalan's preferred range of 0.01-0.8µm. The cited portion of the cited case law does not state that a 35 U.S.C. 103 rejection (as opposed to a 35 U.S.C. 102 rejection) should be made in situations where the prior art teaches a broader range than that claimed by Applicant or where the range of the prior art and that claimed by Applicant overlaps; rather cited portion of the cited case law states that a "prima facie case of obviousness typically exists" (i.e. a 35 U.S.C. 103 rejection can be made). The cited portion of the cited case law does not state that a 35 U.S.C. 102 cannot be made in these situations. The 35 U.S.C. 102 rejection made in this case is proper (see MPEP 2131.03 entitled "Anticipation of Ranges").

Applicant states that Applicant has shown unexpected results in the paragraph bridging pages 8 and 9 of Amdt. C, but Applicant has not met the burden on Applicant to establish that these results are unexpected and significant in that the evidence relied upon does not establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance” *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). See MPEP 716.02(b) and more generally, MPEP 716.02. In the first full paragraph of page 9 of Amdt. C, Applicant argues that “Jalan at no time expresses any interest in the reduction of bottle friction”, but barium sulfate is a friction reducing additive as stated in paragraph 9 of Paper 8. In the paragraph bridging pages 9 and 10 of Amdt. C, Applicant alleges that the “criticality of applicant’s ranges are shown”, but the statements cited in this paragraph are not supported with data.

10. Applicant’s arguments on page 10 of Amdt. C regarding the 35 U.S.C. 103 rejections of claims 13 and 25-30 have been fully considered but are not persuasive (N.B. claim 14 does not stand rejected, it is withdrawn as being drawn to a nonelected invention). Applicant argues that the “issue is not whether it would be obvious to make a 2-liter bottle, or a bottle with a defined wall thickness”, but this is the issue as the art rejections stand, since, e.g., Jalan fails to explicitly teach that the bottle has the wall thickness that is claimed in claims 25 and 26, thus necessitating the rejection of claims 25 and 26 under 35 U.S.C. 103 over Jalan in view of Beck et al.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

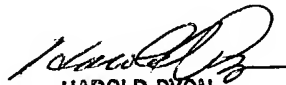
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
04/22/04

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/22/04